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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: G. King

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Serial No.: 09/496,549

I hereby certify that this paper is being sent this  
day via facsimile to 703-872-9314.For: Method and System for Handling  
Telecommunications Data TrafficBrian K. Johnson 46,808  
Attorney Name Reg. No.

Filed: February 2, 2000

Brian K. Johnson March 7, 2002  
Signature Date of Signature

Group: 2662

Examiner: A. Qureshi

Att'y Dkt.: 96 P 7613 US 04

Brief on AppealAssistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This brief is in support of the applicant's February 20, 2002 notice of appeal of  
the final rejection of the claims.

Real Party in Interest

Siemens Corporation, New York, NY.

Related Appeals and Interferences

None.

Status of Claims

Claims 32-39 are pending in this application and stand rejected under 35 U.S.C.  
§ 103(a) as being unpatentable over U.S. Patent No. 5,621,731 (Dale et al.) in view of  
U.S. Patent No. 4,446,337 (Cofer).

The rejection of all of these claims is appealed.

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Status of Amendments

No amendments were submitted after the final rejection.

Summary of the Invention

The applicant's invention obviates the passage of a data call through the switch of a central office by identifying the call as a data call, intercepting the call, and then passing it directly to a router while bypassing the switch.

The purpose of the invention is "sending data, received on a subscriber line connected to a subscriber line module communicating with a central office comprising a switch, directly to a router...." Claim 32. This requires the steps of "intercepting the data on the subscriber line" and "sending the data directly to the router while bypassing the switch" (independent method claim 32 and dependent claims 33-37). As used in the context of the claims, data is a non-voice call.

Issues

Claims 32-39 are not obvious in view of the combination of U.S. Patent No. 5,621,731 (Dale et al.) and U.S. Patent No. 4,446,337 (Cofer) because

there is no disclosure, teaching, or suggestion in either document to intercept a data call on a subscriber line and then bypass the switch; and

there is no teaching or suggestion to modify either of both the cited references to achieve the claimed combination of intercepting a data call on a subscriber line and then bypassing the switch.

Grouping of Claims

Claims 32 and 38 are independent method and apparatus claims, respectively. The applicant respectfully suggests that the method claim 32 may be relied upon to represent the group.

Argument

In the office action mailed November 30, 2001, all of the pending claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,621,731 (Dale et al.) in view of U.S. Patent No. 4,446,337 (Cofer).

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The office action states on page 2 that "Dale discloses a bypass circuit ... [but] fails to disclose an intercepting system." The action goes on to state the "Cofer discloses an automatic intercept system...." It concludes by stating that "[t]herefore, it would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the system disclosed by Dale, by incorporating the automatic intercept system of Cofer that is capable of intercepting [the] call at the subscriber end and sending data to a router at a local exchange bypassing a switch." Office Action, pages 2-3. No evidence is offered to support this conclusion.

This argument fails for at least two reasons. First, there is no teaching or suggestion in either of the references to make such a combination. In and of itself, the bald assertion that "it would have been obvious" to have made the necessary modifications to the references and then combine them as suggested in the office action cannot support a finding of obviousness. In re Lee, \_\_ F.3d \_\_, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002)(Board's affirmation of PTO's unsupported § 103 rejection reversed). Indeed, the only motivation for such a combination is found in the applicant's claims and it is improper to use the applicant's claims in this fashion. M.P.E.P. § 2143 (8th ed., August 2001), page 2100-126 ("[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure"); In re Dembicza, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) ("[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight."); In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) ("rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'"). Nowhere in the references is there a suggestion to intercept incoming data calls and bypass the switch.

Second, the Cofer reference is directed to an automatic intercept system, a scheme utilized by the telephone company to intercept calls that cannot be completed and send an audio message to the calling party informing them of that fact. For example, if the called number is disconnected or the area code has changed, the caller is so informed. In all such cases, the calls are not completed. By contrast, the applicant's data calls go through to the intended recipient.

To use Cofer as suggested in the office action, the messaging system would have to be disconnected and some means of capturing and re-routing the data call would be required. Such a change in the operation of Cofer is not proper. M.P.E.P. § 2143.01 (8th ed., August 2001), p. 2100-125 ("the proposed modification cannot change the principle of operation of a reference"), quoting In re Ratti, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) ("suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the

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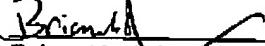
primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate."). The re-engineering required of Cofer thus precludes obviousness.

Since the combination is improper, the claims are allowable over the art and therefore the applicant respectfully requests that the Board reverse the examiner and direct that the application be passed to allowance.

Dated: March 7, 2002

Respectfully submitted,

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Appendix

32. A method for sending data, received on a subscriber line connected to a subscriber line module communicating with a central office comprising a switch, directly to a router, comprising the steps of:

at the subscriber line module, intercepting the data on the subscriber line; and sending the data directly to the router while bypassing the switch.

33. A method as set forth in claim 32 where the step of intercepting the data includes the step of intercepting the data ahead of a switch.

34. A method as set forth in claim 32 where the step of intercepting the data includes the step of intercepting the data ahead of a switching network.

35. A method as set forth in claim 32 where the step of intercepting the data includes the step of intercepting the data ahead of a switch interface module.

36. A method as set forth in claim 32 where the step of intercepting the data includes the step of intercepting the data ahead of a remote line termination unit in communication with the subscriber line module.

37. A method as set forth in claim 32 further comprising the steps of: assigning a logical identifier to the data; and associating the data with the subscriber line.

38. An apparatus for sending data, received on a subscriber line connected to a subscriber line module communicating with a central office comprising a switch, directly to a router, comprising:

means, at the subscriber line module, for intercepting the data on the subscriber line; and

means for sending the data directly to the router while bypassing the switch.

39. An apparatus as set forth in claim 38 further comprising:  
means for assigning a logical identifier to the data; and  
means for associating the data with the subscriber line.

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Your ref:	U.S. Patent Application No. 09/496,549	Our Ref:	Atty. Dkt. No. 96 P 7613 US 04
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**Comments:**

Attached to this facsimile is the following document:

A brief on Appeal (with appendix) 5 pp.

If you have any questions regarding this, please contact me.

Sincerely,

Brian K. Johnson

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